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APPLICANTS: Haber, Jeff
SERIAL NO.: 09/628,569
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TITLE: "Directing Internet Shopping Traffic and
Tracking Revenues Generated as a Result Thereof"
EXAMINER: Andrew J. Rudy
GROUP ART UNIT: 3627
ATTY. DKT. NO.: 04910

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SUBSTANCE OF INTERVIEW WITH EXAMINER

Sir:

An interview was had with Examiner Andrew J. Rudy and his immediate supervisor Robert P. Olszewski on April 20, 2004 and this communication shall serve as summary of the substance of that interview.

INITIAL COMMENTS

At the outset of the interview it became painfully clear that neither the Examiner nor his supervisor had actually read or reviewed the claims in question in a full and appropriate manner as neither was prepared to address certain specific limitations set forth in the claims and previously brought to their undivided attention. This was done in obvious dereliction of

MPEP 713.01 and neither the Examiner nor his supervisor was at all apologetic for their ignorance and ill-preparedness and neither seemed willing to comport with established rules and procedures of the PTO. MPEP 713.01 specifically requires that "examiners should familiarize themselves with the status and existing issues in an application" and further requires that an "examiner should not hesitate to state, if such be the case, that claims presented for consideration at the interview require further search and study."

Additionally, during the course of the interview, Applicant attempted to ascertain what alternate claim language would be acceptable to the Examiner as it was clear there were considerable differences between the cited art and the claimed invention. However, the Examiner and his supervisor were both most uncooperative and unprofessional and, in fact, disconnected the call in a rather rude and discourteous fashion by hanging up on the Applicant mid-sentence. This again was done in complete dereliction of MPEP 713.01 which specifically provides that "the examiner should attempt to identify issues and resolve differences during the interview as much as possible." This was not done and only further evidences the lack of professionalism of the Examiner and his supervisor.

Finally, the Interview Summary prepared and provided by the Examiner in this case is woefully lacking in any of the specifics discussed during the brief interview and does not clearly set forth the position of the Examiner and his supervisor. Applicant believes that the failure of the Examiner and his supervisor to accurately set forth the basis for the continued rejection is merely a symptom of the incompetence which pervades this Art Group. MPEP 713.04 specifically requires that the substance of the interview identify the general thrust of the arguments presented by the applicant and the examiner such that they may be understood by a third party. The Examiner has done nothing more than broad brush this requirement

and, has in fact intentionally misstated the position of the applicant which has now been explained three fold to the Examiner and his supervisor. Moreover, the Examiner and his supervisor have intentionally decided to speak in generalities in an effort to create a cloudy and unproductive haze around this application rather than simply cleanly, clearly and concisely state their position in unequivocal terms. Apparently this type of "gamesmanship" and "lack of candor" is completely acceptable and commonplace in this Art Group.

This Substance of the Interview shall set forth with specificity the fallacious and altogether ludicrous position of the Examiner and his supervisor with specificity and shall further explain why such a position is both logically and legally untenable to even the simplest of minds capable of achieving only a 5th grade reading level.

THE CLAIMS IN QUESTION

Claim 1 of the application is set forth specifically herein verbatim as it now stands with many relevant portions specifically highlighted. Claim 16 is also set forth in a similar fashion.

1. A method for providing internet traffic for on-line shopping:

providing a segment of video content *in a first portion of a display*, said segment of video having a number of products featured in the video content which a user may purchase; simultaneously providing an image *in a second portion of the display*, which image corresponds with the segment of video content, *the image being a select frame from said segment of video and containing a number of user selectable areas*, each user selectable area showing one of the products contained in the corresponding segment of video content, each user selectable area being anchored to a hyperlink, each hyperlink linking to an e-commerce website where specific information about the product resides and from which the product may be purchased; receiving a user's selection of one of the areas in the image showing one of the products contained in the corresponding segment of video content;

using the hyperlink anchored to the user's selected area to directly access the e-commerce website and retrieve the specific information about the product contained in the corresponding segment of video content; and simultaneously providing the specific information about the product to the user *in a third portion of said display.*

Relevant portions of the claim have been highlighted to show that a segment of video is provided in a first portion of a display. An image having a number of user selectable areas, with each such area being anchored to a hyperlink is provided in a second portion of the display. *The image being a select frame from said segment of video.* Finally, once one of the user selectable areas in the image has been selected, specific product information is retrieved using the hyperlink and that information is displayed in a third portion of the display.

Similarly, Claim 16 provides:

16. *a video area for displaying several contiguous segments of video content featuring products featured which may be purchased;*

an image area for simultaneously providing a series of images, each image in the series corresponding with one of the contiguous segments of video content and being a select frame from said corresponding segment of video content, each image containing a number of user selectable areas, each area showing one of the products contained in the corresponding segment of video content, wherein each user selectable area in the image is anchored to a hyperlink which links directly to a sponsor webpage such that when the area is selected, information about the product show in that area, including an option to purchase, is linked directly from the sponsor webpage using the hyperlink, and the information is simultaneously displayed to the user in a third portion of the display.

Once again, relevant portions of the claim have been highlighted and clearly show that several contiguous segments of video are provided in a video area of a display. Simultaneously, a series of images, each image having a number of user selectable areas, with each such area being anchored to a hyperlink, are provided in a separate image area of the display. *Each image in the series is a select frame from its corresponding segment of video content.* Finally, once

one of the user selectable areas in one of the images has been selected, specific product information is retrieved using the hyperlink and that information is then displayed in yet another separate and third portion of the display.

THE SPECIFIC PRIOR ART CITED AND DISCUSSED

The Examiner issued a final rejection of both claims 1 and 16 under 35 U.S.C. 103(a) as being unpatentable over the article entitled "Mitsubishi Electric America Teams with CyberSource to Market and Deliver Multimedia Software Via The Web" (hereinafter referred to as "Mitsubishi") in view of Yeo et al. (U.S. Patent No. 6,219,837) (hereinafter referred to as "Yeo"). Both of these prior art references were discussed in detail during the interview.

The "Mitsubishi" article provided by the Examiner spans an entire two and one quarter pages. Having thoroughly read the article from front to back, Applicant can find only two references in Mitsubishi even remotely relevant to the claimed invention. Applicant will quote both of these passages verbatim so as not to provide any confusion.

First, "Mitsubishi" provides:

VisualSHOCK MOVIE is a leading-edge software component that *enables users to easily embed hyperlinks or "hotspots" into existing digital video*. Available only via electronic download at <http://www.visualshock.com>, VisualSHOCK MOVIE is aimed at professional presenters and Web site developers.

"Mitsubishi" further provides:

VisualSHOCK movie enables users to create interactive video content for presentations, Web pages or training. *A user can take an existing video file – an AVI, QuickTime or MPEG1 format – and create hotspots on that movie that hyperlink to other hot spots in the same movie, additional media, text, sounds, pictures, URLs, additional videos, and even executables.* If an actor, for example, holds up a product in a video, clicking on a VisualSHOCK MOVIE-created hyperlink could take the viewer to a Web page with product information or online sales capabilities.

These passages clearly indicate that what "Mitsubishi" teaches is using special software to embed hyperlinks into "hot spots" *on existing video content* and then while watching the video content a user a may click on those embedded hyperlinks or "hot spots" in the actual moving video in order to jump to other media, including product information and online sales capabilities.

Yeo discloses a main video segment that plays along in an interrupted fashion 18. The video itself is embedded with markers or summary frames. These summary frames depict key scenes from past video segments. As the video plays, these summary frames are displayed 20, 22, and 24. If a user selects one of these scenes or summary frames (20, 22, or 24), the video then jumps to the past video segment with which the summary frame is associated and the past segment of video is then played. The video is then rejoined back to where it left off – allowing a user to have a better sense of what occurred in the past. As Yeo clearly states, "when a channel surfer arrives at a new channel, rather than having only what is currently playing to catch the eye, summary frames are available to catch the surfer's attention and aid in understanding the program."

***THE EXAMINER AND HIS SUPERVISOR'S STATED POSITION
DURING THE INTERVIEW***

The Examiner and his supervisor stated that Claims 1 and 16 would have been obvious in light of the cited references. More specifically, during the interview the Examiner and his supervisor took the legally and factually untenable position that "Mitsubishi" comprised and taught both the first and second claim elements set forth in claims 1 and 16 and that the remaining claim elements would have been obvious in light of Yeo and the general state of the art.

Specifically the Examiner and his supervisor stated that the video content having embedded hyperlinks, as taught by "Mitsubishi" could be divided into two areas. A first area or portion of the video being that area of the video surrounding but not including the spot in the actual moving video where the hyperlink exists and therefore teaching "a segment of video content *in a first portion of a display.*" The Examiner and his supervisor further stated that the second area or portion of the moving video -- that area where the embedded hyperlink is actually found or embedded -- could then be read and interpreted to teach "an image in a second portion of the display, which image corresponds with the segment of video content and containing a number of user selectable areas, each user selectable area showing one of the products contained in the corresponding segment of video content, each user selectable area being anchored to a hyperlink."

While certainly a novel interpretation of the prior art, this position ignores the very limitations of the prior art, discounts the file wrapper and the arguments made by the Applicant, fails to properly apply the law on obviousness, and specifically fails to address limitations set forth in the claim itself. Either the Examiner and his supervisor have failed to verse themselves in the applicable law and are incapable of properly applying the legal standards set forth on obviousness or they have simply failed to actually read the claims in a complete, proper and correct fashion. In either event, their lack of professionalism and their ignorance is nothing short of a stigma on the entire Art Group.

THE APPLICANT'S STATED POSITION

DURING THE INTERVIEW

The invention as claimed, is significantly different from that which is taught by "Mitsubishi" or "Yeo" or their combination. Unlike "Mitsubishi", the hyperlinks in the present

invention are not embedded directly in the streaming video. In fact, Applicant has on numerous occasions recognized that this was well known in the art but is plagued by numerous limitations and problems in its actual implementation. Instead, the hyperlinks in the claimed invention are anchored to still images that correspond with the actual video content. Contrary to the Examiner's opinion, this limitation is specifically called out in the claims. Moreover, the arguments put forth by the Examiner and his supervisor are non-sensical because the claims specifically provide that *the still image in which the hyperlinks are contained is a select frame from the segment of video content*. Therefore, the image cannot be a mere portion of the video content but, rather, must be a separate still image comprised of an entire frame from the corresponding segment of video content. Clearly then, the image must *be a separate and still image and it must be a select frame from the segment of video content and the Examiner and his supervisor have failed to appreciate this distinction. Moreover, they have completely failed to address it.*

In the present invention, a user may then click on products featured in a segment of video by not clicking on the actual moving video; but, rather, by clicking on the product in the still image. Using the hyperlink anchored to the selected area information about the product and purchasing the product will be displayed in a third area of the screen. Accordingly, the Examiner's position is non-tenable.

If one were to modify Mitsubishi to create a separate still image *and then place the hyperlinks in the image instead of inside the actual segment of moving video content*, one would basically modify the reference to the point of making it non-operable. In this regard the law is clear and unmistakable. It is black-letter law that one cannot modify a prior art reference to the point of making it unusable for its intended purpose. *In re Gordon, 733 F.2d 900 (Fed.Cir.*

1984). This difference between the claimed invention and the limitations of "Mitsubishi" is significant and allows more than one product to be clicked on at a time with much more ease and convenience while the video segment continues to play. As explained in the response to the final office action, in a moving image – such as a video segment – the image is constantly moving and being updated. If there is more than one product in the video and a user wishes to purchase or obtain information about each product, he or she must act very quickly to click on both products as the video plays. Alternatively he or she must pause the video. One benefit of the claimed invention is that several products may be depicted throughout and over the course of a segment of video. This video is displayed in one portion or area of the screen display. Meanwhile, each of these products is also featured in a single still image, which is displayed in a separate portion or area of the screen display, the image being a select frame from the segment of video content. Accordingly, a user can click on the featured products at a more leisurely pace as the video continues to play without having to stop the video. "Mitsubishi" does not teach this limitation.

While Yeo may arguably be said to teach displaying images which correspond with video content, it does not teach embedding hyperlinks in these video images such that a user may click on these hyperlinks to jump to product information or on-line shopping capabilities which are then simultaneously displayed in a third and separate portion or area of the screen display. Rather, Yeo teaches embedding markers in a segment of video and then using still images to jump to certain portions of the video where these markers are embedded. Clearly this is not the same and there is no suggestion to modify Yeo in order to embed hyperlinks in the still images in order to achieve the functionality of the claimed invention. In this regard the Examiner and his supervisor have again failed to appreciate long established legal precedent and have made a mockery of the definition of obviousness. The law clearly requires that in order to establish

obviousness, it is incumbent upon the Examiner and the Office to show "that knowledge generally available to one of ordinary skill in the art would lead that individual to combine and modify the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); *In re Lahu*, 747 F.2d 703, 705 (Fed. Cir. 1984); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n. 24 (Fed. Cir. 1985); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). Here the Examiner has failed to provide any information as to how or why one of ordinary skill in the art would combine these references and then modify them given their very different applications, objectives, goals and results.

Finally, and perhaps most egregiously, the Examiner and his supervisor have failed to recognize that when combining prior art references, the combination must teach all of the claimed elements. More specifically, it is black letter law that in order to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the combined prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). Here the combination of "Mitsubishi" and Yeo is woefully lacking in teaching all of the elements of the claimed invention. The combination fails to teach the falling elements:

simultaneously providing an image in a second portion of the display, which image corresponds with the segment of video content, the image being a select frame from said segment of video and containing a number of user selectable areas, each user selectable area showing one of the products contained in the corresponding segment of video content, each user selectable area being anchored to a hyperlink, each hyperlink linking to an e-commerce website where specific information about the product resides and from which the product may be purchased; receiving a user's selection of one of the areas in the image showing one of the products contained in the corresponding segment of video content; using the hyperlink anchored to the user's selected area to directly access the e-commerce website and retrieve the specific information about the product contained in the corresponding segment of video content; and simultaneously providing the specific information about the product to the user in a third portion of said display.

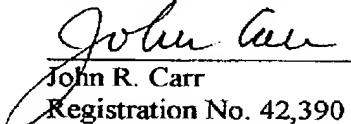
In light of these facts, Applicant submits that neither "Mitsubishi", nor Yeo, nor their combination, teach all of the elements of the claimed invention. Accordingly, the rejection of claims 1 and 16 under §103(a) as being unpatentable over "Mitsubishi" in view Yeo should be withdrawn and the claims should be allowed.

Conclusion

Based upon the foregoing remarks, the Applicant respectfully submit that all of the claims in the instant application are in condition for allowance, and prompt reconsideration and allowance of all claims is hereby solicited.

Respectfully submitted,

Dated: April 27, 2004


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